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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
POLTORAK, PIOTR	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/936,768	FUCARILE ET AL.	
	Examiner	Art Unit	
	Peter Poltorak	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-22,24-27,29-39,41-43 and 45-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-22,24-27,29-39,41-43 and 45-50* is/are rejected.

7)☒ Claim(s) *51-53* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment, and remarks therein, received on 7/28/2005 have been entered and carefully considered.
2. The Amendment introduces a new limitation into the originally sole independent claims 1, 19 and 37 and dependent claims 2, 6-7, 9, 11, 17, 20, 24, 27, 29, 35, 38, 41 and 50, cancels claims 5, 10, 23, 28, 40 and 44 and adds claims 51-53.
   The newly introduced limitation has required a new search and consideration of the pending claims. The new search has resulted in newly discovered prior art. New grounds of rejection based on the newly discovered prior art follow below.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

4. In the amendment applicant argues the newly introduced limitations into the independent claim 1, that are also present in the independent claims 19 and 37. Applicant argues that the newly introduced limitations are not taught in the art of record.
5. The new grounds of rejection address the argued limitations, below.

6. Claims 1-4, 6-22, 24-27, 29-39, 41-43 and 45-53 have been examined.

Claim Rejections - 35 USC § 112

7. Claims 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
8. Claim 47 depends on the cancelled claim 40. For purposes of further examination claim 47 is treated as dependent on claim 37.

Claim Rejections - 35 USC § 102

9. Claims 1, 19 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by *Stannard (U.S. Patent No. 6567107).*
10. As per claim 1 *Stannard* teaches a licensing method and system facilitates the licensing of objects 102 and object libraries 300 for use in a graphic drawing application program *(col. 3 lines 12-15).* The exemplary graphics program 706 utilizes a large number of drawing objects 102 representing various elements, figures or functional blocks that are arranged into several object libraries 300 *(col. 3 lines 23-28).* A license procedure 708 implemented within the graphics program 706 manages licenses for libraries 300 and objects 102 *(col. 3 lines 45-48).*
11. This reads on "the digital content that is subject to a first license and a second license ... wherein the first license corresponds to a first entity and the second license corresponds to a second entity".
12. *Stannard* teaches that "a license procedure 708 implemented within the graphics program 706 manages licenses for libraries 300 and objects 102" *(col. 3 lines 45-48)* and "when the drawing containing unlicensed objects 102 is opened, a warning

message is displayed indicating that the drawings contains unlicensed objects 102. An unlicensed object 102 within the document is displayed with a tag 104 *(col. 3 line 65-col.4 line 2 and Fig. 1)*. In particular, in Fig. 2 *Stannard* discloses an exemplary object record 200 that includes a license indicator 202. The object record 200 is created within the document file when the user inserts the object 102 from the library to the document. The license indicator data 202 is a single that indicates whether the tag 104 should be coupled to the object and if it is coupled, the tag record is used to form the tag over the object 102 *(col. 4 line 65- col. 5 line 19)*. If a valid license is obtained the data in the object record 200 is modified to remove the instruction to include the tag 104 by setting the license indicator 202 to the appropriate value *(col. 5 lines 44-47)*.

13. This reads on "examining the digital content to identify data indicating that the content is subject to a first license and a second license, determining a status of the licenses based on the data; and processing the digital content subject to the status".

14. Claims 19 and 37 are substantially equivalent to claim 1; therefore claim 19 and 37 are similarly rejected.

Claim Rejections - 35 USC § 103

15. Claims 1-4, 6-7, 9,11-22, 24-25, 27, 29-39, 41, 43 and 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larose et al. (U.S. Patent No. 6108420)* in view of *Knapton (U.S. Patent No. 6363486)*.

16. As per claims 1-2, 6-7 and 19 *Larose et al.* invention is related to a software application that is authenticable and traceable to a particular user. *Larose et al.*

teach Secure Distribution Agent (SDA) that provides aggregate distribution file to a User Installation Agent (UIA) *(Larose et al., col. 4 line 63-col. 5 line 5). Larose et al.* teach that "the SDA 100 combines the identifying data 32, 34 with the data stored in the databases 20 to produce an aggregated distribution file 170 that is uniquely customized, authenticable, and traceable to the user. The aggregate distribution file 170 is transmitted via the distribution channel 300 to the UIA 200. The output from the UIA 200 is a uniquely customized software application 15 (to be referred to below as an "installed aggregate distribution file") installed on the installation computer, with identifying information embedded therein" *(Larose et al., col. 5 lines 33-52).*

17. *Larose et al.* discloses upgrade of "an installed aggregate distribution file 15 present on an installation computer. In this case, the UIA 200 and the SDA 100 would verify of the license status of the installed aggregate distribution file 15 present on the installation computer, and then invoke the method and system disclosed herein to construct, deliver and install an upgraded version of the installed aggregate distribution file 15 to the installation computer. The capability to invoke the upgrading feature of the present invention could be done at the request of the user, or it could be invoked automatically upon detection by the UIA 200 of the availability of a new version of the original distribution file 130" *(Larose et al., col. 14 lines 25-37).*

18. This reads on examining digital content to identify data indicating that the content is subject to a license, determining a status of the license based on the data; and processing the digital content subject to the status.

19. *Larose et al.* do not teach that data indicates the first license that corresponds to a first entity and the second license corresponding to a second entity.

20. *Knapton* teaches applications that utilize multiple components *(Knapton, col. 4 lines 27 and Fig. 1, object 12)* that are subject to licensing and only licensed components are used with the application *(Knapton, col.4 lines 6-9)* that reads on the first license that corresponds to a first entity and the second license corresponding to a second entity.

21. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the first license that corresponds to a first entity and the second license corresponding to a second entity. One of ordinary skill in the art would have been motivated to perform such a modification in order to provide greater flexibility with application programs by structuring portions or features of the software as separate components so that only components desired by the end user are licensed *(Knapton, col. 1 lines 11-22)*.

22. One of ordinary skill in the art would have also appreciated the fact that any upgrades *(e.g. like taught by Larose et al.)* could be easily limited only to particular components.

23. *Larose et al.* teach the limitations of claims 3 and 17-18 in col. 6 lines 22-24 and 38-49.

24. As per claims 4 and 14 *Larose et al.* teach the data including a portion (signature) for determining whether the digital content has been altered *(Larose et al. col. 3 lines 50-56)*.

25. As per claims 12-13 the at least a portion of the digital content is part of the digital content.

26. The limitations of claims 15 and 16 are implicit; computers use plurality of routines to accomplish different tasks.

27. Claims 19-22, 24-25, 30-39, 41 and 45-50 are substantially equivalent to claims 1-4, 6-7, 12-18; therefore claims 19-22, 24-25, 30-39, 41 and 45-50 are similarly rejected.

28. As per claims 9, 11, 27, 29 and 43 *Larose et al.* and *Knapton* do not teach utilizing a cache to store entries corresponding to the data, determining validity of the cache entry and requesting the status of the licenses from the server if the cache entry is not valid.

29. However, utilizing a cache to store entries corresponding to the data as well as checking validity of the cache entries is old and well-known in the art *(cookies, DNS entries etc.)* and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize a cache to store entries corresponding to the data as well as checking validity of the cache entries given the benefit that caching data speeds up the performance and placing the validation requirement on the cache entries *(e.g. time limit on cached data)* ensures that the data is refreshed and as a result that it reflects any potential changes applied to the data after the data has been cached.

30. Checking whether the cache entry has not expired and requesting the status of the licenses from the server if the cache entry has been found to be expired would be implicit.

31. Claims 8, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larose et al. (U.S. Patent No. 6108420)* in view of in view of *Knapton (U.S. Patent No. 6363486)* and further in view of *Brachtl et al. (U.S. Patent No. 4908861)*.

32. *Larose et al.* in view of *Knapton* teach data comprising an encrypted portion and sending a portion of the data to the server as discussed above. *Larose et al.* in view of *Knapton* do not explicitly teach sending the encrypted portion.

Brachtl et al. teach sending an encrypted portion *(Brachtl et al., Fig. 1)*. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send the encrypted portion as taught by *Brachtl et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to assure process integrity *(Brachtl et al., col. 3 lines 50-54 and col. 4 lines 1-68)*.

33. Claims 1-4, 6-22, 31-39 and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Horstmann (U.S. Patent No. 6009401)* in view of *Knapton (U.S. Patent No. 6363486)*.

34. As per claim 1 *Horstmann* teaches software installation that includes a license certificate *(col. 3 lines 60-62)* stored on a user machine *(Horstmann, col. 3 lines 38-40)*. *Horstmann* teaches checking the license terms *(as shown in Table 1)* and trial parameters *(Horstmann, col. 3 lines 53-56)* and allowing a software trial.

35. *Horstmann* does not teach the first license that corresponds to a first entity and the second license corresponding to a second entity.

36. *Knapton* teaches applications that utilize multiple components *(Knapton, col. 4 lines 27 and Fig. 1, object 12)* that are subject to licensing *(Knapton, col.4 lines 6-9)*,

which reads on the first license that corresponds to a first entity and the second license corresponding to a second entity.

37. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to configure *Horstmann's* invention so that multiple software components correspond to multiple licenses and as a result to have the first license that corresponds to a first entity and the second license corresponding to a second entity. One of ordinary skill in the art would have been motivated to perform such a modification in order to provide greater flexibility with application programs by structuring portions or features of the software as separate components so that the end user could select only desired licensed components *(Knapton, col. 1 lines 11-22)*.

38. One of ordinary skill in the art would have also appreciated the fact that implementing *Knapton's* multiple components would allow advertising and selling of new components developed to already existing/enquired applications by the end user.

39. As per claim 2 examining the digital content includes searching for license statements *(Horstmann, License terms within Table 1)*.

40. As per claims 3 and 4 the data includes a human readable portion *(Horstmann, name and address of licensee, Table 1)* and encrypted portion *(Horstmann, digital signature, Table1)*.

41. As per claims 5 and 13 the license is part of the digital data *(Horstmann, Abstract)*.

42. As per claims 15 and 16 *Horstmann* teaches conditional allowance of a software trial *(Horstmann, col. 3 lines 53-55).*

43. Claims 19-22, 31-34, 37-39 and 47-49 are substantially equivalent to claims 1-4, 6-16; therefore claims 19-22, 31-34, 37-39 and 47-49 are similarly rejected.

44. As per claims 17 and 18 *Horstmann* in view of *Knapton's* teach determining a status of the licenses as discussed above.

Horstmann in view of *Knapton's* do not teach determining a status of the license comprising determining and indicating to a user that the license is for non-commercial use.

Official Notice is taken that it is old and well-known that license can be restricted to commercial or non-commercial use and based on the restriction a the licensed material may be utilized differently. It is also old and well-known to indicate to a user that the content is licensed for non-commercial use. One of ordinary skill in the art at the time of applicant's invention would have been motivated to incorporate the determining and indicating to a user that a license is for non-commercial use into *Horstmann's* invention in order to warn the user about the content restrictions.

45. Claims 35-36 and 50 are substantially equivalent to claims 17-18; therefore claims 35-36 and 50 are similarly rejected.

46. Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Horstmann (U.S. Patent No. 6009401)* in view of *Knapton (U.S. Patent No. 6363486)* and further in view of in view of *Larose et al. (U.S. Patent No. 6108420).*

47. *Horstmann* in view of *Knapton's* teach the portion of the data *(a digital signature, Table 1)* and the digital content as discussed above. *Horstmann* in view of *Knapton's* do not teach determining whether the digital content has been altered using the portion data.

48. *Larose et al.* teach determining whether the digital content has been altered using the portion data *(col. 3 lines 43-56).*

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate determining whether the digital content has been altered using the portion data as taught by *Larose et al.* into *Horstmann* in view of *Knapton's* invention. One of ordinary skill in the art would have been motivated to perform such a modification in order to detect the digital content alternation.

49. Claims 1, 6, 12, 19, 24, 30, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Coley et al. (U.S. Patent No. 5790664)* in view of *Knapton (U.S. Patent No. 6363486).*

50. As per claim 1 and 6 *Coley et al.* teach client application *(digital content)* comprising a client module *(data indicating that the content is subject to a license. It also includes IP address of the computer as discussed bellow)* that sends enquiry to a license server *(col.4 lines 22-32).* Upon receipt of the license record the application is enabled *(col. 4 lines 44-46).*

Coley et al. teach a license record identifying a license in accordance with a hardware identifier such as an IP address *(col. 4 lines 30-33)* and the request message containing information such as the application information and a hardware

identifier, such as the IP address of the computer *(portion of the data indicating that the content is subject to a license) (col. 9 lines 3-8).*

51. As per claim 12, requesting the license status is part of processing the data.

52. Claims 19, 24, 30, 37 are substantially equivalent to claims 1, 6 and 12; therefore claims 19, 24, 30, 37 are similarly rejected.

53. Claims 7-9, 11, 25-27, 29 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Coley et al. (U.S. Patent No. 5790664)* in view of *Knapton (U.S. Patent No. 6363486)* and further in view of *Tootle (U.S. Patent No. 5787174).*

54. *Coley et al.* teach sending a portion of the data *(IP address)* to the server as discussed above.

Coley et al. do not explicitly teach the identifier *(portion of the data)* being encrypted.

Tootle teaches encrypting the identifier *(Tootle, col.5 lines 24-40).*

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to encrypt the identifier as taught by *Tootle* into *Coley et al's* invention.

One of ordinary skill in the art would have been motivated to perform such a modification in order to avoid duplicate entries within the license database stored on the license server. (*Using unencrypted hardware identifier to identify a license of the computer such as an IP address (Coley et al. col.4 line 30-32) may produce unexpected results. For example, duplicate IP addresses can be encountered (internal IP address don't have to be unique). Using a private key encryption as taught by Toole ensures that the identifier will be unique.)*

55. Claims 9-11, are taught by *Coley et al.* in col. 6 lines 10-53.

56. Claims 25-27, 29 and 41-43 are substantially equivalent to claims 7-9 and 11; therefore claims 25-27, 29 are similarly rejected.

Conclusion

Claims 51-53 remain objected to as being dependent on rejected claims 1, 19 and 37. Claims 51-53 would overcome the art of record if rewritten in independent form.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Signature

10/17/05

Date

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